

## **REMARKS**

### ***Summary of Office Action***

In the Office Action, the Examiner rejected claims 1 and 20 under 35 U.S.C. § 101 for allegedly being directed to non-statutory subject matter. In particular, the Examiner submitted that the process must be tied to another statutory class or transform underlying subject matter to a different state or thing. However, the Examiner helpfully provided that explicitly claiming the medium or structure in the body of the claim that performs the underlying process steps would serve to better recite the technological arts within the present set of claims. Furthermore, the Examiner graciously concluded that claims 1, 3-7, 11, 14, 16-20, 26-33, and 35-37 distinguish over the prior art and would be allowable upon overcoming the non-statutory subject matter rejection. Additionally, as evidenced by the Examiner's Interview Summary mailed August 5, 2008, the Examiner conducted a telephonic interview with Ms. Abigail Cotton on July 22, 2008 discussing the § 101 rejection of claims 1 and 20. During this interview, the Examiner reiterated that the claim language should include the medium or structure performing the method steps in order to overcome the § 101 rejection. No other issues were presented.

### ***Summary of Amendments***

Upon entry of the present Response to Office Action, claims 1 and 20 will have been amended. As such, claims 1, 3-7, 11, 14, 16-20, 26, 28-33, and 35-37 remain currently pending. By the present amendment, Applicant submits that the rejections have been overcome and respectfully requests reconsideration of the outstanding Office Action.

*Applicant's Response*

1. Section 101 Rejection of Claims 1 and 20

Applicant's independent claim 1 as currently amended recites, inter alia, "...obtaining information from said individual in step (i), ... storing such information in electronic medical records embodied on a computer readable medium ..." Similarly, Applicant's independent claim 20 as currently amended recites, inter alia, "...obtaining information from said individual in step (i), ... storing such information in electronic medical records embodied on a computer readable medium ..." "

Applicant respectfully submits that the current amendments overcome the 35 U.S.C. § 101 rejection and place the claims in condition for allowance, at least for the reason that the claimed methods now explicitly require the use of technological arts, in that patient information is stored in electronic medical records on a computer readable medium. As the Examiner indicated in the Office Action (See Page 3, Paragraph Number 8), "explicitly claiming the medium or structure in the body of the claim that performs the underlying process steps would serve to better recite the technological art..."

As is well known, a claim reciting an abstract idea can state statutory subject matter only if, "it is embodied in, operates on, transforms, or otherwise involves another class of statutory subject matter, i.e., a machine." *In re Comiskey*, 84 USPQ2d 1670, 1678 (Fed. Cir. 2007). Along these lines, the Federal Circuit recently reiterated this line of thinking in *In re Bilski*, wherein the court stated that "a claimed process is surely patent-eligible under §101 if: (1) it is tied to a particular machine *or* apparatus, or (2) it transforms a particular article into a different state or thing." 88 USPQ2d 1385, 1391 (Fed. Cir. 2008).

In the current situation, after having been amended, the claims now recite that the information received from patients are stored in electronic medical records embodied on a

computer readable medium. The currently amended claims thus are tied to a particular machine. As such, Applicant respectfully submits that the claims now are in condition for allowance and requests that the 35 U.S.C. § 101 rejection be withdrawn.

Furthermore, Applicant respectfully submits that no new matter has been added by the current amendments. In particular, Applicant's specification, as originally submitted, recites numerous times that the potential patient submits data indicative of his or her demographics, *as per conventional health insurance application procedures* or *per conventional practices, such as those utilized by health maintenance organizations*. See, e.g., Paragraphs [0012] and [0028]. Applicant respectfully submits that it is common practice and well known for patient data to be collected and/or stored in electronic medical records embodied on a computer readable medium. In fact, many of the prior art references previously cited by the Examiner in this application discuss and/or utilize such well known electronic medical record practices.

For example, the Bond et al. patent (U.S. Patent No. 6,177,940) discusses in the Background various methods for entering patient information into electronic storage databases, for example, transcription from pen and paper collection, scanning computerized forms, and direct individual-computer interactive programs. Similarly, the Background of the Invention section of the Provost et al. patent (U.S. Patent No. 6,341,265) discusses claims processing systems utilizing electronically created and submitted medical insurance claims. Furthermore, the Background of the Invention section of the Summerell et al. patent (U.S. Patent No. 5,937,387) discusses various prior art that, among other things, disclose automated medical history taking, devices for recording patient history, and digital database storage of patient attributes. These prior art references are not believed to affect the patentability of Applicant's claimed invention, as they are directed toward different processes; however, they merely serve to show that electronic medical record storage on computer readable mediums was well known in the art and is part of the conventional

practices and procedures within the medical industry. As such, Applicant respectfully submits that no new matter has been added by these amendments.

In conclusion, Applicant respectfully submits that the claims, as currently amended, are sufficiently tied to statutory matter so as to overcome any 35 U.S.C. § 101 rejection. Furthermore, Applicant respectfully submits that no new matter has been added to the currently amended claims, as Applicant's specification explicitly discloses that patient data is obtained/submitted via conventional procedures and practices, wherein it has been shown that it was well known to utilize electronic medical records embodied on computer readable media. Finally, Applicant appreciates the Examiner's indication that Applicant's claims distinguish over the prior art and are allowable but-for the § 101 rejection, which Applicant respectfully submits has been overcome by the present amendments and above arguments.

*Conclusion*

Applicant respectfully submits that each and every pending claim of the present invention meets the requirements for patentability under 35 U.S.C. §§ 101, 112, 102, and 103, and respectfully requests that the Examiner indicate allowance of each and every pending claim of the present invention.

In view of the foregoing, it is submitted that each of claims 1, 3-7, 11, 14, 16-20, 26, 28-33, and 35-37 are now properly and sufficiently tied to statutory subject matter.

Accordingly, reconsideration of the outstanding Office Action and allowance of the present application and all the claims therein are respectfully requested and now believed to be appropriate.

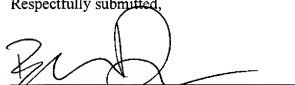
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Respectfully submitted,

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